

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket № 14286US02)

In the Application of:

Jeyhan Karaoguz

Serial No. 10/667,833

Filed: September 22, 2003

For: MEDIA EXCHANGE NETWORK

SUPPORTING CONSUMPTION OF

BROADCAST AND USER CAPTURED

MEDIA

Examiner: Umar Cheema

Group Art Unit: 2444

Confirmation No. 1002

Electronically filed on 29-AUG-2011

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection of the USPTO ("Office") in the above-identified application, stated in the final Office Action mailed on April 15, 2011 ("Final Office Action") with a period of reply through September 15, 2011, pursuant to the Petition for 2 Month Extension of Time. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS

Claim 1-48 were rejected on grounds of non-statutory obviousness type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 7,483,985, claims 131 of U.S. Patent No. 7,424,534, and claims 1-33 of U.S. Patent Application No. 10/675,410. Claims 1-48 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. 7,065,778 ("Lu") in view of U.S. 20020154892 ("Hoshen"), in further view of U.S. 20040125789 ("Parker"). Applicants respectfully traverse the rejections for the reasons set forth during prosecution, and those presented below.

I. Non-Statutory Obviousness Type Double Patenting

Claims 1-48 were rejected on grounds of non-statutory obviousness type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 7,483,985, claims 1-31 of U.S. Patent No. 7,424,534, and claims 1-33 of U.S. Patent Application No. 10/675,410. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office has not established a *prima facie* case of either anticipation or obviousness with respect to claims 1-48 over the cited claims of any of U.S. Patent No. 7,424,534, U.S. Patent No. 7,483,985, or Application Serial No. 10/675,410. Initially, the support provided by the Office for this rejection is simply a two-column listing of the language of only claims 1-5 of the Application, aligned with claim 1 of Application Serial No. 10/675,410 and claims 1-5 of U.S. Patent No. 7,424,534. The Office fails to even address rejected claims 6-48 of the Application, and fails to address any of the claims of U.S. Patent No. 7,483,985.

Further, although the Office has arranged selected claims in a side-by-side format, the Office fails to provide the required "...reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention...." Applicants respectfully submit that the Office does not provide any explanation of why the elements of Applicants' claims are either anticipated or obvious in view of the cited claims of U.S. Patent No. 7,424,534, U.S. Patent No. 7,483,985, or Application Serial No. 10/675,410. For example, Applicants respectfully submit that the Office action fails to even show every feature of claim 1 of U.S. Patent Application No. 10/675,410. Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of either anticipation or obviousness, and respectfully request that the non-statutory obviousness-type double patenting rejection of claims 1-48 be withdrawn.

II. The Proposed Combination of Lu, Hoshen, and Parker Does Not Render Claims 1-48 Unpatentable

Claims 1-48 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. 7,065,778 ("Lu") in view of U.S. 20020154892 ("Hoshen"), in further view of U.S. 20040125789 ("Parker"). Applicants respectfully traverse the rejections. **With regard to independent claim 1**, Applicants respectfully submit that claim 1 recites, *inter alia*, "second software configured to enable a user at the first home to construct, at the first home, at least one user defined media channel, the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home." Independent claims 15, 25, 30, and 35 recite similar language. The Applicants respectfully submit that the proposed combination of Lu, Hoshen, and Parker does not describe, teach, or suggest all aspects of Applicants' claims 1, 15, 25, 30, and 35.

Initially, Applicants respectfully submit that the rejection of claim 1 in the instant Office action is identical to the rejection of claim 1 set forth in the previous Office action. *Compare* February 2, 2010 Office action at pages 3-6 to August 31, 2010 Office action at pages 7-10 and the current Final Office Action at p. 10-13. Applicants addressed the alleged teachings of the cited art in detail at pages 16-28 of the response filed June 2, 2010. Applicants will not repeat all of the arguments of June 2, 2010 again here, but hereby incorporate them herein as though set forth in full. Additionally, based on M.P.E.P. §707.07(f), the Examiner has an **obligation** to not only respond to the arguments presented by the Applicants, but to **address the substance** of those arguments.

As noted above, the present rejection of claim 1 is identical to and is therefore merely a repeat of the rejection set forth in the February 2, 2010 Office action and the August 31, 2010 Office Action. However, the Office has not addressed the substance of Applicants' arguments to this repeated rejection, as required by M.P.E.P. §707.07(f), but instead simply repeats a part of the rejection to which Applicants' response was directed.

Applicants respectfully submit that the Office again admits that Lu and Hoshen in combination do not disclose at least the above aspect of Applicants' claim 1. *See* Final Office action at page 12. The Office, however, then turns to Parker, and states the following:

10. In analogous teaching, Parker exemplifies this where Parker teaches wherein second software configured to enable a user at the first home to construct (a network-enabled personal computer workstation 14; Fig. 1), at the first home, at least one user defined media channel (see VT and Record Database Server 35; Fig. 1), the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home (see fig. 1 and details wherein a data network interconnects the service provider workstation and the requester communication device, and the service provider workstation and the requester communication device have respective network addresses. A requester information database stores a data record corresponding to the requester. The requester communication device includes a signaling device for generating a request signal and a controller responsive to the request signal for initiating a video communication link between the requester communication device and the service provider workstation using the respective network addresses and for initiating display of the data record at the service provider workstation).

(emphasis added)(*See* Final Office action at page 13.) As an initial point, Applicants respectfully submit that the Office fails to specifically cite any text from Parker to shed light on why the Office selected the elements of Parker identified above, and merely copies the underlined portion of text that appears at the Abstract and paragraph [0009]. The Office fails to explain how this portion of Parker supports the rejection by teaching Applicants' claimed subject matter, as required by M.P.E.P. §2142. In particular, the Office does not explain specifically how and why the identified elements and the underlined text from Parker teach all of the features of Applicants' claim 1 admittedly missing from the proposed combination of Lu and Hoshen. This defect of the instant Office action is common to the arguments presented over the features of at least claims 1, 15, 25, 30, and 35. Thus, Applicants respectfully maintain that the Office has not established a *prima facie* case of obviousness at least because the Office does not explicitly demonstrate how all aspects of Applicants' claim 1 are taught by the cited art.

Applicants respectfully maintain that the invention of Parker relates to "a video telephony system for conducting

communications supplemented by presenting digital data records to a service provider automatically in response to a video telephony call.” *Id.* at para. [0003]. Parker teaches a “computer workstation 14” is used by a “service provider,” described by Parker as a “medical caregiver.” *Id.* at Abstract. The “medical caregiver” receives video telephony calls initiated by a “service requester” (a “medical patient”) from the location of a “requester communication device.” *Id.* at Abstract and ¶[0019]. Video calls to the “medical caregiver” are initiated from the “requester communication device” manually (e.g. by push button) or automatically (e.g., caused by telephone call to particular number or by “patient monitor 33”). *Id.* at paras. [0020], [0023], [0024]. A “data record” stored in a “requester information database 35” or provided by the “requester communication device” is made available to the “medical caregiver” at “computer workstation 14.” *Id.* at Abstract, paras. [0018], [0022], [0024].

The Office seems to assert that the “network enabled personal computer workstation 14” of FIG. 1 of Parker teaches Applicants’ “second software configured to enable a user at the first home to construct, [at the first home, at least one user defined media channel].” *See* Final Office action at page 13. The Office also seems to assert that the “VT and Record Database Server 35” somehow teaches Applicants’ “at least one user defined media channel.” *Id.* In addition, the Office seemingly asserts that the “data network” of Parker teaches Applicants’ claimed “second software” that enables “enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home.” *Id.* Applicants again respectfully disagree that Parker teaches what is asserted, and disagree that Parker remedies the admitted failings of Lu and Hoshen. Applicants respectfully submit that Parker is deficient for a number of reasons.

Applicants respectfully submit that the Office has not shown where and how Parker teaches, suggests, or discloses “closed and secure communication of the at least one user defined media channel to others (plural) within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home.” As noted above, the Office seems to assert that the “network enabled personal computer workstation 14” of FIG. 1 of Parker teaches Applicants’ “second software configured to enable a user at the first home to construct, [at the first home, at least one user defined media channel].” Also as noted above, the Office seems to assert that the “VT and Record Database Server 35” somehow teaches Applicants’ “at least one user defined media channel.” Applicants respectfully submit, however, that Office has failed to demonstrate that Parker teaches communication of any piece of information from the “VT and Record Data Server 35” to a plurality of recipients from the location of the “service provider/medical caregiver,” in accordance with claim 1. Instead, Parker merely teaches that the “data record” corresponding to a “requester” is displayed at the “service provider workstation.” *See id.* at Abstract; Ref. 67 of FIG. 5; paras. [0003], [0008], [0009], [0020], [0025], [0033]. Thus, for at least these reasons, Applicants respectfully submit that Parker fails to teach, suggest, or disclose at least this aspect of Applicants’ claim 1 admittedly missing from the proposed combination of Lu and Hoshen.

In addition, Applicants respectfully maintain that Applicants’ “at least one user defined media channel” is quite different from the “VT and Data Record Server 35,” which the Office asserted teaches this aspect of claim 1. Applicants’ disclosure teaches, *inter alia*, that a “media channel” comprises “personal digital media (e.g., captured digital pictures, digital video, digital audio, etc.).” Application at para. [0062]. Applicants respectfully submit that while limitations from the Specification are not to be read into the claims, the claims are to be given their broadest reasonable interpretation, **consistent with the Specification.** *See* M.P.E.P. §904.01 and §2145(VI). Applicants respectfully submit that interpretation of Applicants’ “at least one user defined media channel” as a “server” is not consistent with the teachings of Applicants’ Specification. The Office has not explicitly demonstrated that Parker teaches, suggests, or discloses that the “server 35” comprises “digital media” of the types described by Applicants’ Specification. Thus, for at least these reasons, Applicants respectfully maintain that Parker fails to teach, suggest, or disclose at least this aspect of Applicants’ claim 1 admittedly missing from the proposed combination of Lu and Hoshen.

If the Office meant to assert that a requester “data record” stored on the “VT and Data Record Server 35” teaches Applicants’ “at least one user-defined media channel,” Applicants respectfully maintain that the Office has not explicitly demonstrated that Parker teaches, suggests, or discloses that the requester “data record” of Parker is “constructed” by the “service provider/medical caregiver.” Parker teaches that the “data record” corresponding to a “request” is sent from the “requester communication device” or another location, and that the “service provider” may “update” a “data record” of a “requester.” *See, e.g., id.* at Refs. 63 and 68 of FIG. 5; Ref. 86 of FIG. 6; paras. [0006], [0008], [0009], [0018], [0025],

[0026]; [0027], [0030], [0034], and [0036]. Therefore, Applicants respectfully submit that Parker teaches, at most, that the “service provider/medical caregiver” may modify a “data record,” but the Office does not show where Parker teaches “construction.” In addition, as noted above, the Office fails to explicitly demonstrate that Parker teaches, suggests, or discloses that any “data record” is communicated to “others” (plural) of a “closed and secure group of users,” as required by Applicants’ claim 1. Instead, Parker simply teaches that the “data record” corresponding to a “requester” is, for example, “one or more computer files” pertaining to the “requester.” See paras. [0008], [0018], [0027]. Further, Parker teaches that the “data record” corresponding to a “requester” is merely displayed at the service provider workstation. See *id.* at Abstract; Ref. 67 of FIG. 5; paras. [0003], [0008], [0009], [0020], [0025], [0033]. Thus, for at least these reasons, Applicants respectfully maintain that Parker fails to teach, suggest, or disclose at least this aspect of Applicants’ claim 1 admittedly missing from the proposed combination of Lu and Hoshen.

Therefore, for at least the reasons set forth above, Applicants respectfully maintain that, contrary to the repeated assertions of the Office, Parker does not remedy the admitted deficiencies of Lu and Hoshen. The Office again admits that Lu and Hoshen do not teach, suggest, or disclose, at least, “second software configured to enable a user at the first home to construct, at the first home, at least one user defined media channel, the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home.” See August 31, 2010 Office action at page 9. Applicants have again demonstrated that Parker also does not teach, suggest, or disclose these features of Applicants’ claim 1. Because the Office admits that Lu and Hoshen do not teach, suggest, or disclose at least these aspects of claim 1, and Applicants have demonstrated that Parker also does not teach, suggest, or disclose at least these aspects of claim 1, it necessarily follows that the proposed combination of Lu, Hoshen and Parker cannot teach, suggest, or disclose at least these aspects of claim 1. Applicants respectfully submit that the Office therefore has not established a *prima facie* case of obviousness, as required by M.P.E.P. §2142 for at least the reasons set forth above.

Applicants respectfully submit that claim 1 also recites, in part, “software that maintains a user defined association of the first and second network protocol addresses, that receives a request that identifies one of the associated first and second network protocol addresses and responds by identifying the other of the associated first and second network protocol addresses to support delivery via the communication network of the 3rd party media from the at least one server, and the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television, and the 3rd party media and the first media by the second television.”

In the instant rejection, the Office again relies only upon Lu and only at col. 6, lines 21-28 and “display 212” of “PVR 200,” asserting that these cited portions of Lu alone teach, at least, “the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television, and the 3rd party media and the first media by the second television.” The Office does not assert that Hoshen and/or Parker provide any support in regard to rejection of these aspects of claim 1. Applicants respectfully disagree with what Lu is asserted to teach. A review of Lu shows that “display device 212” appears in FIG. 2, FIG. 3, and FIG. 4, but none of those illustrations of the system of Lu teaches, suggests, or discloses, at least, “the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television, and the 3rd party media and the first media by the second television,” contrary to the conclusory statement by the Office. That is, there is nothing in FIGs. 2, 3, or 4 that teaches anything about consumption of “3rd party media” from a “server” by a television at a “first home,” concurrent with consumption, by a second television at a “second home,” of the “3rd party media” and “media from a storage at the first home.” It is simply not there. Further, the Office fails to provide the “explicit analysis” required by M.P.E.P. §2142 to explain how Lu is interpreted to teach what is asserted.

Applicants now turn to Lu at cited col. 6, lines 21-29. Applicants respectfully maintain that the portion of Lu shown above fails to make any mention of concurrent consumption of media at first and second homes, let alone that a television at the “first home” consumes media from a “3rd party,” while a second television at the second home consumes the media from the “3rd party” and media from a storage at the “first home.” Instead, the cited portion of Lu, specifically selected by the Office, simply explains that “display device 212” may be “cathode ray tube (CRT), flat panel liquid crystal display (LCD),

field emission display (FED), or any other display device suitable for displaying video and/or graphic images and alphanumeric characters recognizable to a user.” Thus, the Office has not demonstrated that Lu teaches, suggests, or discloses “the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television, and the 3rd party media and the first media by the second television.” Because Lu does not teach, suggest, or disclose at least this aspect of Applicants’ claim 1, and the Office has not even asserted that either Hoshen or Parker teach anything in this regard, Applicants respectfully submit that it necessarily follows that the Office has not shown that the proposed combination of Lu, Hoshen, and Parker teaches, suggests, or discloses at least this aspect of Applicants’ claim 1.

Applicants respectfully submit that the rejection of claim 1 again consists simply of the text of Applicants’ claim 1, interspersed with citations to portions of Lu, Hoshen, and Parker. For example with respect to the rejection of admitted deficiencies in Lu and Hoshen, the Office simply reproduces Applicants’ claim text, inserts vague references to two elements of FIG. 1 of Parker, adds, verbatim, text that appears in both the Abstract and paragraph [0009] of Parker (without identifying its source), and then concludes with the conclusory statement that it would be obvious to combine the references. Therefore, should the Office choose to maintain the rejection, Applicants once again respectfully request that the Office specifically identify the relevant portions of the cited art, down to paragraph/column and line(s) and elements of figures that allegedly teach each and every element of Applicants’ claims. Applicants respectfully maintain that the instant Final Office action, which merely repeats the rejections of the February 2, 2010 and August 31, 2010 Office actions, does not answer those questions and merely repeats a portion of the rejection of claim 1 taken from the February 2, 2010 and August 31, 2010 Office actions. Therefore, Applicants respectfully submit that the Office has not provided the “explicit analysis” and “articulated reasoning” required by M.P.E.P. §2142, and that claim 1 is allowable for at least this reason. With regard to independent claims 15, 25, 30, and 35, Applicants respectfully submit that claims 15, 25, 30, and 35 recite many of the same features and were rejected over the same art for the same reasons set forth in the rejection of claim 1, and that claims 15, 25, 30, and 35 are allowable over the cited art for at least some of the reasons set forth above with respect to the rejection of claim 1.

III. Conclusion

The Applicant respectfully submits that claims 1-48 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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